

PATENT APPLN. NO. 10/758,541  
RESPONSE UNDER 37 C.F.R. §1.111

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REMARKS

In the Action of April 25, 2006, the Office has withdrawn claims 2 and 4 from consideration as being directed to a non-elected invention and has removed the rejection of the claims made in the first Action of August 4, 2005. The Office is now rejecting claim 1 as being obvious under 35 U.S.C. § 103(a) over Kaneko, U.S. Patent No. 5,840,166, and is rejecting claim 3 as being obvious under 35 U.S.C. § 103(a) over Kaneko in view of JP-2001-316744 (cited in the first Action).

Only a discussion of the rejection of claim 1 is required. If the rejection of claim 1 is overcome, claim 3, which depends on claim 1, will be *prima facie* patentable.

Referring to the rejection of claim 1, Kaneko is cited by the Office as disclosing a negative electrode comprising a hydrogen absorbing alloy within the scope of the formula of the hydrogen absorbing alloy recited in claim 1. Kaneko discloses a hydrogen absorbing alloy having the formula  $(R_{1-x}L_x)(Ni_{1-y}M_y)_z$ , where R is La, Ce, Pr, Nd or mixtures thereof, L is Gd, Tb, Dy, Ho, Er, Tm, Yb, Lu, Y, Sc, Mg, Ca or mixtures thereof, M is Co, Al, Mn, Fe, Cu, Zr, Ti, Mo, Si, V, Cr, Nb, Hf, Ta, W, B, C or mixtures thereof,  $0.05 \leq x \leq 0.4$ ,  $0 \leq y \leq 0.5$  and  $3.0 \leq z \leq 4.5$ . The Office has arbitrarily selected R, L and M and values of x, y and z to arrive at a

hydrogen absorbing alloy that is within the scope of the formula recited in claim 1 of the application. The Office cites the decision of the United States Court of Appeals of the federal Circuit in *Merck & Co. Inc v. Biocraft Laboratories*, 10 USPQ2d 1843 (1989), as support for the obviousness of selecting an alloy from the alloys within the formula disclosed in Kaneko.

Applicants respectfully submit that the *Merck* decision does not support the arbitrary selections made by the Office. The *Merck* decision requires that the prior art must give some direction as to which of many possible choices is likely to be successful (in the claimed invention). Applicants' invention is not merely an alkaline storage battery in which the negative electrode comprises a hydrogen absorbing alloy of the formula recited in claim 1. The alkaline storage battery of claim 1 requires a positive electrode comprising nickel hydroxide as a positive electrode active material and a negative electrode comprising (a) a hydrogen absorbing alloy having a specified formula and a specified hydrogen content and (b) carbon as a conductive agent.

Kaneko does not disclose or suggest that hydrogen absorbing alloys having a formula within the scope of claim 1 will provide good results if the hydrogen content is maintained within a specified limit and the negative electrode comprises carbon as a

conductive agent and is combined with a positive electrode comprising nickel hydroxide as a positive electrode active material.

All of the alloys within the scope of the formula of the hydrogen absorbing alloy disclosed in Kaneko will not necessarily have a hydrogen content within the scope of the hydrogen content recited in claim 1. This fact is demonstrated by the data of Table 1 of the application in which the hydrogen absorbing alloy of Comparative Example 1 is within the scope of the formula of the hydrogen absorbing alloy disclosed in Kaneko, but does not have a hydrogen content of not greater than 0.01 as required by claim 1.

Moreover, as explained in the response filed November 4, 2005, to the first Action, an alloy within the scope of the formula recited in claim 1 will also not necessarily have a hydrogen content and water content within the scope of the limitation recited in claim 1. The conditions of preparation of the alloy are important in controlling the hydrogen content and water content of the alloy. As described in the present application on page 6, lines 14-18:

The hydrogen and water content in the hydrogen absorbing alloy are a function primarily of the composition of the alloy and can be adjusted, as required, by controlling the conditions of preparing the alloy, i.e., dissolution, casting and heat treatment.

For the above reasons, Kaneko is insufficient to support a case of *prima facie* obviousness under 35 U.S.C. § 103(a) of claim 1 (and claim 3) of the present application and removal of the 35 U.S.C. § 103(a) rejections is in order.

The foregoing is believed to be a complete and proper response to the Office Action dated April 25, 2006, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

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In the event any additional fees are required, please also  
charge our Deposit Account No. 111833.

Respectfully submitted,

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